

REMARKS/ARGUMENTS

The current amendment is responsive to the final Official Action mailed June 25, 2003. A Notice of Appeal is also transmitted herewith, along with a petition for a three-month extension of the term for response to said Official Action, to and including December 25, 2003.

In said final Official Action, the Examiner indicated that claims 6-9, 13, 16-19, 30 and 33-36 were objected to as being dependant on rejected base claims, but would be allowable if rewritten in independent form, including the base claim and any intervening claims. By the present amendment, claim 6 has been amended to incorporate verbatim the recitations of claims 1, 4 and 5 as they stood prior to the present amendment. Claim 13 has also been amended to incorporate the recitations of claims 1, 4 and 5. Claim 16 has been amended to stand in independent form and to incorporate the recitations of claim 1 as it stood prior to the present amendment, whereas claims 30 and 33 have each been amended to stand in independent form and to include the recitations of claim 29 as it was prior to the present amendment. It is believed that these amendments clearly place claims 6-9, 13, 16-19, 30 and 33-36 inclusive in allowable condition. Moreover, these amendments are clearly enterable under 37 C.F.R. § 1.116(b) as complying with a requirement of form expressly set forth in a previous Official Action.

Independent claims 1 and 29, and certain dependent claims, were rejected under 35 U.S.C. § 102(b) as assertedly anticipated by *Tanaka*, JP 3-94459. It is noted that this rejection also encompasses independent claim 38. (Final Official Action, ¶ 6.) However, claim 38 was canceled (Final Official Action, ¶ 1), and it is accordingly understood that the indication that claim 38 was rejected is a typographical error.

By the present amendment, independent claims 1 and 29 have been amended to further specify the "electrically resistive

material" as a material including conductive particles in a binder, as explicitly set forth in the specification (§ 0070). This amendment is believed necessary to meet the Examiner's contention that because "every material has some level of electrical resistivity" (Official Action at 3), the sealing material of *Tanaka* would be an "electrically resistive material" as originally set forth in the claim. That contention was first advanced in the final Official Action. Therefore, the amendments believed desirable to meet that contention were not earlier presented. It is respectfully submitted that these amendments should be entered pursuant to 37 C.F.R. § 1.116(c). Moreover, it is respectfully submitted that these amendments clearly place independent claims 1 and 29, and all of the other claims dependent thereon, in condition for allowance.

As previously pointed out, *Tanaka* seeks to make a semiconductor chip package and, accordingly, encapsulates the semiconductor chip 10, bonding wires 20 and bond pads in a "sealing resin 22." Manifestly, that sealing resin must be a dielectric material, i.e., a material which does not conduct electricity to any significant extent and which, therefore, has an extremely high electrical resistivity which, for practical purposes, may be regarded as an infinite electrical resistivity. If the sealing material of *Tanaka* were not a dielectric, the electrically conductive components such as the bond wires 22 and bond pads of the reference would be electrically connected to one another, so that all of the signal contacts of the semiconductor chip would be electrically connected to one another, thereby rendering the chip inoperative. Manifestly, *Tanaka* has no place for "electrically conductive particles" in its sealing material. The function of such electrically-conductive particles, of course, is to increase the electrical conductivity, and hence decrease the resistivity, of a composite material.

Applicant had previously disputed (and continues to dispute) whether or not one could regard *Tanaka's* dielectric sealing material as an "electrically resistive material," as that term is used in claim 1. The Examiner apparently disagrees with the applicant on this point. But most assuredly, *Tanaka's* dielectric material has not been shown to contain "electrically conductive particles in a binder" as now recited. It does not anticipate amended claims 1 and 29 under § 102. Although no rejection of the claims under § 103 has been made, it is noted that there is no motivation to use any such composition in *Tanaka's* device. Again, *Tanaka* seeks to insulate the various components from one another. The notion of including electrically-conductive particles, which would render the material more conductive, less resistive and less able to insulate the components from one another, is contrary to the entire thrust and content of the reference.¹

The § 102 rejection of claims 1, 4, 5, 10-12, 14, 15, 20, 24, 27, 29 and 37 should be withdrawn for the reasons stated above.

Claims 2, 3, 25, 26 and 31 were rejected under 35 U.S.C. § 103(a) as unpatentable over *Tanaka* as applied to claim 1, taken in view of *Lake et al.*, U.S. Patent 5,937,512. This rejection should be withdrawn for the same reasons as discussed above. *Lake* has not been cited as teaching anything which would remedy the deficiencies of *Tanaka* pointed out above.

It is believed that all of the objections and rejections set forth in the Official Action have been fully met by the foregoing amendments and remarks. However, if any further action on the part of applicant is believed necessary to

¹ Out of an abundance of caution, counsel notes that applicant is not here alleging that compositions including electrically-conductive particles in a binder *per se* are unknown. Such compositions are shown, e.g., in *Zhang et al.*, U.S. Patent 5,864,281, of record, in an environment entirely different

place this case in condition for allowance, the Examiner is respectfully urged to telephone undersigned counsel at (908) 518-6450 to discuss the matter.

If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

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Respectfully submitted,

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from that of Tanaka and for an entirely different purpose than the insulating sealing resin of Tanaka.